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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1944

No. 1897

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AUTOMATIC PAPER MACHINERY COMPANY, INC.,
Petitioner

vs.

MARCALUS MANUFACTURING COMPANY, INC.,
and NICHOLAS MARCALUS
Respondents

MOTION TO SUBSTITUTE PETITIONER AND
MEMORANDUM IN SUPPORT THEREOF.

GEORGE E. MIDDLETON
Counsel for Petitioner

SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1944

No. 1097

AUTOMATIC PAPER MACHINERY COMPANY, INC.,
Petitioner

vs.

MARCALUS MANUFACTURING COMPANY, INC.,
and **NICHOLAS MARCALUS,**
Respondents

MOTION TO SUBSTITUTE PETITIONER

May it Please the Court:

NOW COMES PETITIONER, AUTOMATIC PAPER MACHINERY COMPANY, INC., and representing to the Court that on May 25, 1945, it assigned the entire right, title and interest in and to the patent in suit, No. 1,843,429, to SCOTT PAPER COMPANY of Chester, Pennsylvania, a corporation organized and existing under the laws of the state of Pennsylvania, together with the right to continue the prosecution of this action and to recover all profits and damages awarded, moves that SCOTT PAPER COMPANY be substituted as petitioner herein. SCOTT PAPER COMPANY hereby joins in this motion. A copy of the assignment is annexed.

Respectfully submitted,

AUTOMATIC PAPER MACHINERY COMPANY, INC.
SCOTT PAPER COMPANY

By **GEORGE E. MIDDLETON,**
Counsel for Petitioner and
Scott Paper Company.

Respondents consent to the substitution of SCOTT PAPER COMPANY as petitioner herein.

June 7, 1945.

SAMUEL E. DARBY, JR.,
Counsel for Respondents.

ASSIGNMENT

In consideration of One Dollar (\$1.00) and other good and valuable consideration, the receipt of which is hereby acknowledged, **AUTOMATIC PAPER MACHINERY COMPANY, INC.**, a corporation organized and existing under the laws of the State of New Jersey, and having its principal place of business at Hoboken, New Jersey, does hereby sell, assign and transfer to **SCOTT PAPER COMPANY**, a corporation organized and existing under the laws of the State of Pennsylvania, and having its principal place of business at Chester, Pennsylvania, the entire right, title and interest in and to:

(1) The following United States Letters Patents:

<i>Title</i>	<i>Patent No.</i>	<i>Patent Date</i>
Winding Machine	1,776,263	September 23, 1930
Box for Dispensing Rolled Paper	1,816,384	July 28, 1931
Wax Paper Package	1,827,029	October 13, 1931
Mounting Cutters on Box Blanks	1,843,429	February 2, 1932
Machine for and Method of Winding Folded Webs	1,884,783	October 25, 1932
Paper Roll	1,884,784	October 25, 1932
Box Machine	1,947,561	February 20, 1934

together with all extensions and renewals and the right to sue for and recover all profits and damages for all past infringements thereof; including expressly the right to continue the prosecution of the pending action entitled *Automatic Paper Machinery Company, Inc. v. Marcalus Manufacturing Company, Inc.*, and *Nicholas Marcalus*, for infringement of U. S. Patent No. 1,843,429, February 2, 1932, now before the Supreme Court of the United States on petition for writ of certiorari to the United States

Circuit Court of Appeals for the Third Circuit granted April 30, 1945, and to recover all profits and damages for past infringements awarded in that action.

- (2) The following application for United States Letters Patent:

<i>Title</i>	<i>Serial No.</i>	<i>Filing Date</i>
Dispensing Box for Waxed Paper	530,145	April 8, 1944

together with all divisions and continuations thereof and all patents that may be issued thereon.

- (3) The right to sue for and recover profits and damages for all past infringements of the following expired U. S. Letters Patents:

<i>Title</i>	<i>Patent No.</i>	<i>Expiration Date</i>
Winding Machine	1,628,322	May 10, 1944
Web Winding Machine	1,628,323	May 10, 1944
Box for Paper Rolls	1,630,495	May 31, 1944
Web Winding Machine	1,669,832	May 15, 1945

IN TESTIMONY WHEREOF the said AUTOMATIC PAPER MACHINERY COMPANY, INC., has caused this instrument to be executed by its officers hereunto duly authorized this 25th day of May, 1945.

AUTOMATIC PAPER MACHINERY COMPANY, INC.
By ROSWELL H. RAUSCH,
President.

Attest:

B. E. SNYDER,
Secretary.

(Corporate Seal)

(Duly acknowledged on May 25, 1945.)

MEMORANDUM IN SUPPORT OF MOTION

Petitioner having assigned the patent in suit, together with the right to continue the prosecution of this action and the right to recover all profits and damages awarded, now moves that the assignee be substituted as petitioner.

An assignee of a patent and also the claim for past infringements of it may sue for infringements committed prior to the assignment. *Crown Die & Tool Co. v. Nye Tool & Machine Works*, 261 U. S. 24, 43. When such an assignment of the patent in suit is made *pendente lite* it has been the practice of the federal district and circuit courts of appeals in patent infringement actions to permit substitution of the assignee as party plaintiff. *Denaro v. McLaren Products Co., et al.*, 9 F. 2d 328, 330; *Irving Air Chute Co. v. Switlik Parachute and Equipment Co.*, 26 F. Supp. 329, 330. Rule 25 (c) of the Federal Rules of Civil Procedure provides that:

"In case of any transfer of interest, the action may be continued by or against the original party, unless the court upon motion directs the person to whom the interest is transferred to be substituted in the action or joined with the original party."

Substitution would appear to be imperative when an injunction is sought. *Mendez v. Bowie*, 118 F. 2d, 435, 439.

We have been unable to find a case in which a patentee-plaintiff assigned the entire interest in his patent while before this Court. On principle, however, we see no reason why the assignee should not be substituted. *Oklahoma Gas Co. v. Oklahoma*, 273 U. S. 257; *Ex parte Railroad Co.*, 95 U. S. 221, 222.

Respondents have consented to the substitution.

Respectfully submitted,

GEORGE E. MIDDLETON,
Counsel for Petitioner.